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10/538,894	06/14/2005	Joachim Berthold	FR 6082 (US)	5148

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EXAMINER	
HEINCER, LIAM J	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Response to Amendment

The proposed amendment has not been entered as it would require new consideration. The two claimed properties added to claim 1 have previously been presented with the third property of stress-crack resistance (see claim 5). The two claimed properties in the absence of the stress-crack resistance limitation have not been previously considered.

Response to Arguments

Applicant's arguments, see pages 2-10, filed January 14, 2009, with respect to the rejection over Moriguchi et al. (US Pat. 4,536,550) as evidenced by DeChellis et al. (US Pat. 5,405,922) have been fully considered and are persuasive. The rejection of claims 1 and 3-5 has been withdrawn. The references together do not provide motivation to a person having ordinary skill in the art at the time of invention to alter the amount of comonomer in the polyethylenes of Moriguchi et al. Moriguchi et al. broadly teaches that comonomers can be used, but neither Moriguchi et al. nor DeChellis et al. provides motivation to alter the amount of comonomer to gain a specific result.

Applicant's arguments filed January 14, 2008 have been fully considered but they are not persuasive, because:

A) Applicants attempt to disqualify Berthold et al. (US Pat. 6,713,561) under 35 U.S.C. 103(c) is insufficient to overcome the rejection. To invoke the commonly assigned applications of 103(c), applicant is required to definitely state that the

applications were commonly assigned or subject to an obligation of assignment at the time of invention. Applicants argument that "it is believed" that the applications were commonly assigned at the time of invention is insufficient. The rejection would be removed with a proper statement.

B) Applicants argument that Berthold et al. (WO 01/23446) only teaches broad ranges rather than the narrow ranges of the claims is not persuasive. In the case where the claimed ranges "overlap or lie inside ranges disclosed by the prior art" a *prima facie*case of obviousness exists. *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976). See MPEP § 2144.05. Applicants can rebut a *prima facie* case of obviousness based on overlapping ranges by showing the criticality of the claimed range. "The law is replete with cases in which the difference between the claimed invention and the prior art is some range or other variable within the claims. . . . In such a situation, the applicant must show that the particular range is critical, generally by showing that the claimed range achieves unexpected results relative to the prior art range." *In re Woodruff*, 919 F.2d 1575, 16 USPQ2d 1934 (Fed. Cir. 1990). See MPEP § 2144.05. The applicant has not established that the claimed ranges result in unexpected results. Therefore, the claimed invention is still prima facie obviousness in view of Berthold et al.

C) Applicants argument of unexpected results is not persuasive. To establish unexpected results over a claimed range, applicants should compare a sufficient number of tests both inside and outside the claimed range to show the criticality of the claimed range. *In re Hill*, 284 F.2d 955, 128 USPQ 197 (CCPA 1960). See MPEP § 716.02(a). The applicant has thus far only provided one working example, and no

examples outside the claimed ranges. Therefore, the data is insufficient to show the criticality of the claimed ranges.

D) In response to applicant's argument that the references do not recognize the claimed impact strength and swell ratio, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). Berthold et al. renders the claimed composition obviousness. When the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). Therefore the properties would implicitly be present in the prior art.

E) Applicants argument that double patenting rejections do not provide rationale for the rejection is not persuasive. The rationale is clearly set out in the previous action, pages 8-11, which compare the current claims to the conflicting claims, then provides rationale for why the claimed invention is obvious in view of the conflicting claims.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Liam J. Heincer whose telephone number is 571-270-3297. The examiner can normally be reached on Monday thru Friday 7:30 to 5:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Eashoo can be reached on 571-272-1197. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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/Mark Eashoo/
Supervisory Patent Examiner, Art Unit 1796

LJH
January 21, 2009